

REMARKS

Claims 1-5, 9-29, and 33-47 are rejected as anticipated by Holtz. Claims 6-8 and 30-32 are rejected as obvious over Holtz in view of Plotnick. Claims 1, 4, 13, 25, 37, and 38 have been amended, and claims 2, 3, 12, 14, 15, 17, 26, 33-36, 39, and 44-47 have been canceled. No new matter has been added by the present amendments. In view of the amendments and the Remarks, the Applicant respectfully requests allowance of the pending claims.

Rejections under 35 U.S.C. § 102(e)

A proper rejection of a claim under 35 U.S.C. 102 requires that a single prior art reference disclose each element of the claim. *W.L. Gore & Assoc., Inc., v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994). For anticipation, there must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech. Inc.*, 927 F.2d 1565, 18 (Fed. Cir. 1991).

Rejections under 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaack*, 947 F.2d 488, 493 (Fed. Cir. 1991); M.P.E.P. § 2143.

The Supreme Court recently reaffirmed use of the *Graham* factors for determining obviousness under 35 U.S.C. § 103(a). *KSR Int'l Co. v. Teleflex, Inc. (KSR)*, No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope

and content of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); 35 U.S.C. § 103.

In *KSR*, the Supreme Court recognized that the requirement for a teaching, suggestion, or motivation to modify or combine the references and arrive at the claimed invention provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a). *KSR* at 14, 15. In addition, the Court maintained that any analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it is “important to identify reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, because “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.*

Independent Claim 1

Claim 1 stands rejected as anticipated by Holtz. The Applicant respectfully traverses the rejection of claim 1 for at least the reason that Holtz does not disclose every step of claim 1.

To support a rejection of claim 1, the Office Action states that Holtz discloses:

a combiner for combining the second image with the first image or
a third image to form a targeted integrated image for delivery to
the user (Enhanced media server 115, Fig. 1; col. 16 line 15-col. 17
line 5; col. 25 lines 34-58)

The Applicant respectfully disagrees with the above-reasoning. Claim 1 recites creating a targeted integrated image by combining two images “to form a targeted integrated image for delivery to the user.” Thus, the images are combined before being delivered to the user. To further this clarify this point, claim 1 has been amended to recite that the targeted integrated image is delivered to the user.

Holtz at Col. 16, lines 34-52 only discloses:

Enhanced media server 115 would acknowledge receipt to the user of all of the necessary specifications. During the time preceding the start of the customized program (i.e., 9:35 A.M. EST), enhanced media server 115 provides the user with advertisements. As this is going on, enhanced media server 115 begins a search for appropriate segments from each of the hosting media facilities (i.e., local and national television stations) according to the geographical parameters specified by the user. The assembly time varies depending on numerous factors, such as number of requested segments, geographic source of the segments, bandwidth availability, time of day, etc. The media production can be assembled for immediate transmission or delayed, as in this example, the user requested the media production to begin at a certain time (i.e., 9:35 A.M. EST).

Enhanced media server 115 assembles these segments and orders them according to the program specifications. Upon completion of the advertisements, the user begins receiving the customized program, which is made up of segments and additional advertisements. (Emphasis added)

Holtz at Col. 3, lines 51-58 discloses:

The client includes a graphical user interface (GUI) that permits the user to select various options to customize the transmission or request a standard program. For example, the user has the option of selecting a live or prerecorded news program to be transmitted. The user could also select specific segments from one or more news programs, and arrange the segments to be presented in any order.

As seen above, Holtz discloses alternating between recorded video segments and advertisements. Holtz does not, however, combine images to create an integrated image for delivery to a user as recited in claim 1. Accordingly, claim 1 is allowable over Holtz for at least the reason that Holtz does not disclose combining two images to create a targeted integrated image for delivery to the user, as recited in claim 1.

Claim 1 is also therefore allowable for at least the reason that Holtz does not disclose combining the second image comprising a barker advertising content of potential interest to the

user with the first image or the third to form a targeted integrated image for delivery to the user, as recited in claim 1.

Claim 1 is also allowable for at least the reason that Holtz does not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user while the user is receiving a first image comprising a trick file comprising a subset of frames from a video file for viewing via digital cable television, as recited in claim 1. First, for example, Holtz does not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user, as recited in claim 1.

To support a rejection of claim 3, which is relevant here, the Office Action states that:

Holtz teaches an apparatus (with respective method), wherein the user preference includes information representing content viewing habits or content ordering habits of the user (col. 18 lines 35-55; col. 32 lines 32-64; col. 37 lines 43-63; col. 44 lines 46-53).

Holtz at Col. 18, lines 35-55 only discloses:

At step 1608, enhanced media server 115 collects various types of data from the enhanced media client 120 in regards to the media production. In an embodiment, the quantity and types of linked advertisements are logged and tracked. In another embodiment, data is collected to track the quantity of click-throughs, page-views, hits and the like for each linked advertisement. The data tracking functionality of the present invention is provided to measure the quantity of consumers that actually receive a specific advertisement. In an embodiment, pricing models are based on consumer demand and behavioral patterns, and the sponsor of the advertisement is invoiced accordingly. The revenue generated from the pricing models are apportioned among network participants, including, but not limited to, (1) the television stations or other media hosting facilities which create or provide the media production, (2) the operator of the portal hosting the web page that permits the user to request the media production, and (3) other participants in the network. Upon collection of the advertisement metrics and the accounting of the advertisement revenue, the control flow ends as indicated at step 1695.

As seen above, Holtz discloses links and click-throughs, but does not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user, as recited in claim 1. The Applicant has considered the other cited passages from Holtz, and respectfully asserts that they do not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user, as recited in claim 1. Accordingly, the Applicant respectfully asserts that claim 1 is allowable for at least the reason that the cited language does not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user, as recited in claim 1.

Second, Holtz does not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user while the user is receiving a first image comprising a trick file, as recited in claim 1.

Third, by extension, Holtz also does not disclose determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user while the user is receiving a first image comprising a trick file comprising a subset of frames from a video file for viewing via digital cable television, as recited by claim 1.

In view of the discussion above, the Applicant respectfully asserts that claim 1, when properly considered as a whole, is allowable over Holtz for at least the reason that Holtz does not disclose every step of claim 1. There is clearly a difference between claim 1 and Holtz as viewed by a person of ordinary skill in the field of the invention.

Independent Claim 25

Claim 25 is allowable for at least the reasons given above for the allowability of claim 1. Claim 25 is also allowable for several additional reasons. First, claim 25 is allowable because the cited language does not show the apparatus of claim 25 wherein the first image comprises a menu or a programming guide.

Second, claim 25 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 25 wherein the processor determines the content of potential interest to the user based on the menu or programming guide selections made by the user.

Third, claim 25 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 25 wherein the combiner inserts the second image within the first image or the third image, wherein the first image or the third image is adapted to appear to the user to be paused. Accordingly, the Applicant respectfully requests allowance of claim 25.

Dependent Claims 4, 27, and 28

Claims 4, 27, and 28 were rejected with claim 3. The language used to support a rejection of claim 3 is distinguished above. Accordingly, the Applicant respectfully asserts that claim 4 is allowable for at least the reason that Holtz does not disclose the method of claim 1, wherein content ordering habits includes at least one of information indicating times at which the user previously viewed or ordered content, genres of content previously viewed or ordered by the user, characteristics of content previously viewed or ordered by the user, and menu selections made by the user.

Claim 27 is allowable for at least the reason that Holtz does not disclose the apparatus of claim 25, wherein the user preference includes information representing content viewing habits or content ordering habits of the user.

Claim 28 is allowable for at least the reason that Holtz does not disclose the apparatus of claim 27, wherein the information representing content viewing or content ordering habits includes at least one of information indicating times at which the user previously viewed or ordered content, genres of content previously viewed or ordered by the user, characteristics of content previously viewed or ordered by the user, and menu selections made by the user.

Claims 4, 27, and 28 are also allowable for at least the reason that each depends from an allowable claim.

Dependent Claims 5 and 29

To support a rejection of claim 5, the Office Action states:

Regarding claims 5 and 29, Holtz teaches an apparatus (with respective method), further comprising determining an identity of the user, wherein the content of potential interest to the user is determined based on an at least one user preference associated with the identity of the user (Fig. 12 or col. 44 lines 1-24. Given that you have to login to access the content with a login, and that the tracking of the behavior of the user for creating a profile is performed when having the content, inherently, the profile is related to the login shown at Fig. 12). (Emphasis added)

The Applicant respectfully disagrees. The cited language only discloses:

FIG. 12 illustrates another embodiment of a client GUI (shown as streamer 1200) for use with an enhanced media server 120. In streamer 1200, media access area 1112 provides a login menu that enables a user to access the content of enhanced media server 120. Auxiliary media 1108a displays an HTML page from a web site that is linked to the current media stream shown by media viewer 1102.

The above streamer embodiments have been described with reference to the hosting site being the actual broadcaster or content supplier. As such, the streamer components are implemented in the web site hosted by the local broadcaster. The present invention can also be implemented with a third party portal. For example, referring to FIG. 2, in an embodiment, managing server 215 is configurable to receive requests for media productions directly from enhance media clients 120a-120d. In this embodiment, managing server 215 would query the appropriate enhanced media server 115a-115b for the media production and for display on GUI designed for the host of managing server 215.

An embodiment of a third party GUI is shown in FIG. 13. Streamer 1300 permits the streamer components to be presented on a third party GUI with the third party host identified by advertisement banners 1114c-1114d.

It can be seen above that the cited language does not disclose determining an identity of the user, wherein the content of potential interest to the user is determined based on at least one user preference, as recited in claims 5 and 29. The fact that a user can log into a media server plainly does not disclose determining potential content of interest as recited in claims 5 and 29.

Further, the Office Action has not satisfied the burden defined in M.P.E.P. § 2112 for a showing of inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Office Action does not satisfy its burden under M.P.E.P. § 2112 to show that the subject matter of claims 5 and 29 is inherently disclosed by a user logging into a media server, as alleged in the Office Action. The cited language does not disclose, expressly or inherently, determining content of potential interest based on a user preference, as recited in claims 5 and 29. Such a rejection clearly fails to support a *prima facie* case of anticipation. Accordingly, claims 5 and 29 should be allowed. Claims 5 and 29 are also allowable for at least the reason that each depends from an allowable claim.

Dependent Claims 9-11, 13, 16, 37-38, and 40

Claim 9 is allowable for at least the reason that the cited language does not disclose the method of claim 1, wherein the first image includes at least a menu or a programming guide. Claim 9 is also allowable for at least the reason that it depends from an allowable claim.

Claim 10 is allowable for at least the reason that the cited language does not disclose the method of claim 9, wherein the step of determining is initiated in response to the user accessing the menu or programming guide. Claim 10 is also allowable for at least the reason that it depends from an allowable claim.

Claim 11 is allowable for at least the reason that the cited language does not disclose the method of claim 9, wherein the step of determining is performed based on menu or programming guide selections made by the user as the user navigates through the menu or programming guide. Claim 11 is also allowable for at least the reason that it depends from an allowable claim.

Claim 13 is allowable for at least the reason that the cited language does not disclose the method of claim 1, wherein the step of determining is initiated responsive to the user requesting the video content. Claim 13 is also allowable for at least the reason that it depends from an allowable claim.

Claim 37 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 25, wherein the processor begins determining content of potential interest to the user responsive to the user requesting the video content. Claim 37 is also allowable for at least the reason that it depends from an allowable claim.

Claim 38 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 25, wherein the processor begins determining content of potential interest to the user as the user receives the video content. Claim 38 is also allowable for at least the reason that it depends from an allowable claim.

Claim 40 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 25, wherein the third image includes at least a menu, a programming guide, or video content. Claim 40 is also allowable for at least the reason that it depends from an allowable claim.

Dependent Claims 18-20 and 41-43

Claim 18 is allowable for at least the reason that the cited language does not disclose the method of claim 1, further comprising repeating the steps for creating at least one new targeted integrated image for delivery to the user. Claim 18 is also allowable for at least the reason that it depends from an allowable claim.

Claim 19 is allowable for at least the reason that the cited language does not disclose the method of claim 18, wherein the steps are repeated as the user continues to request or receive images. Claim 19 is also allowable for at least the reason that it depends from an allowable claim.

Claim 20 is allowable for at least the reason that the cited language does not disclose the method of claim 18, wherein the steps are recursively repeated for delivering new targeted integrated images for delivery to the user. Claim 20 is also allowable for at least the reason that it depends from an allowable claim.

Claim 41 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 25, wherein the processor repeatedly determines and selects content of potential interest, and the combiner repeatedly combines the selected content with an image for creating at least one new targeted integrated image for delivery to the user. Claim 41 is also allowable for at least the reason that it depends from an allowable claim.

Claim 42 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 41, wherein new targeted integrated images are created as the user continues to request or receive images. Claim 42 is also allowable for at least the reason that it depends from an allowable claim.

Claim 43 is allowable for at least the reason that the cited language does not disclose the apparatus of claim 41, wherein new targeted integrated images are recursively created for delivery to the user. Claim 43 is also allowable for at least the reason that it depends from an allowable claim.

Claims 18-20 and 41-43 are also allowable for at least the reason that the Office Action does not satisfy its burden under M.P.E.P. § 2112 to show that the subject matter of claims 18-20

and 41-43 is inherently disclosed “Given that the profiles dynamically change and that the user can change the preferences . . . it is inherent that the matching content will be different and new”, as alleged in the Office Action. Further, claims 18-20 and 41-43 do not simply recite “matching content”, so assuming arguendo that the alleged subject matter is inherently disclosed by Holtz, claims 18-20 and 41-43 are still allowable.

Dependent Claim 21

Claim 21 is allowable for at least the reason that the cited language does not disclose the method of claim 1, further comprising compressing at least one of the first image, the second image, and the third image prior to forming the targeted integrated image. Claim 21 is also allowable for at least the reason that it depends from an allowable claim.

Dependent Claims 22-24

To support a rejection of claims 22-24, the Office Action states:

Regarding claims 15,22-24,39 and 45-47, Holtz teaches an apparatus (with respective method) wherein the combiner inserts the second image within the first image or the third image, wherein the first image or the third image is adapted to appear to the user to be paused, for delivery or upon delivery (Given that user can 'trick-play' the content, including pausing it -col. 42 lines 10-39- , that the content is sent together with the advertisement and that the advertisement and other enhanced data could be watched in a different display next to the content display- col. 35 lines 3-23; col. 38 lines 34-50, it is inherent that the ads or other enhanced data can be inserted while the actual video appears paused to the user. In other words, the enhancement content can be viewed at the display next to the paused video display).

The Applicant respectfully disagrees. First, claims 22-24 are allowable because the Office Action does not satisfy its burden under M.P.E.P. § 2112 to show that the subject matter of claims 22-24 is inherently disclosed because a user can pause content “and that the advertisement and other enhanced data could be watched in a different display next to the

content display”, as alleged in the Office Action. Second, claims 22-24 are allowable for at least the reason that each depends from an allowable claim.

Dependent Claims 6-8 and 30-32

Claims 6-8 and 30-32 are allowable for at least the reason that the cited language does not disclose the methods or apparatuses of claims 6-8 and 30-32. Claims 6-8 and 30-32 are also allowable for at least the reason that each depends from an allowable claim.

CONCLUSION

In view of the above, each of the presently pending claims in the Application is believed to be in immediate condition for allowance. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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